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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,166	11/29/2000	Robert Barritz	P/1318-119	1178
2352	7590	01/09/2004	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			LE, DAVID Q	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/726,166

Applicant(s)

ISOGON CORPORATION

Examin r

David Q Le

Art Unit

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-- The MAILING DATE of this c mmunication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Examiner's Note**

1. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all passages in the cited references as potentially teaching all or part of the claimed inventions.

### ***Status of Claims***

2. Per the Amendment filed on October 3rd, 2003 (Paper No. 5):

**Claims 1 and 17** have been amended.

**Claims 1 – 40** remain pending.

### ***Response to Request for Reconsideration***

3. The request for consideration filed on October 3rd, 2003 (above Paper No. 5) under 37 CFR § 1.111 has been considered but is ineffective to overcome **Bains et al.**, US Patent 5,579,222 in view of **Ginter et al.**, US Patent 5,892,900.

### ***Response to Arguments***

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4. Applicant's arguments have been fully considered but they are not persuasive:

Applicant argues that neither Bains nor Ginter discloses or teaches that their license manager gathers data and the usage of licensed property by reference to a plurality of licensors.

Applicant is respectfully directed to Bains' Fig. 1, and the associated text at Col. 5, lines 28-35: "...running a variety of software products, such as PDS (item 12a), EMS (item 12b), and so forth (shown through item 12j)." As is evident from Fig. 1 and the cited text, a plurality of such software products may be controlled by a license manager/monitor. Further text discloses that multiple "licensing systems" may be referenced by this license manager/monitor (Col. 7, lines 17-19); that the licensed products thus controlled may comprise "various software products" (Col. 7, lines 21-23; Fig. 2, item 26); that the system will pick which licensing system to access "depending on the software product .. and information in the policy server database" (Col. 7, lines 28-30). In addition, Figs. 2-6 and associated text (Col. 7, line 17 – Col 8, line 52) make it clear that Bains' invention envisions a license manager/monitor that will control, gather data, and report on multiple licensed properties to a plurality of licensors.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **1-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bains et al.**, US Patent 5,579,222 in view of **Ginter et al.**, US Patent 5,892,900.

As per **claims 1 and 17.**

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Bains describes a system for administering license compliance on a network (Abstract; Summary of the Invention; Fig 1, associated text; see citations used in Response to Arguments section above). Ginter discloses a Virtual Distribution Environment (VDE) wherein a license compliance verification system may be set up to monitor the use of licensed property and gathers data on the use of this property (Abstract; Background and Summary of the Invention(s); Figs 1-5B; 77-79; 85-87; associated text).

Neither Bains nor Ginter specifically recites all the limitations of claims 1 and 17. However it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined the features taught by Bains and Ginter to arrive at a license compliance system and method meeting all the limitations of these claims, in order to provide a trusted, secure, and tamper free license monitoring system for use by licensors, thus making software licensors/publishers more attracted to offering their products to user organizations:

*A license compliance verification [system and method], comprising: a license manager that internally monitors use of licensed property (Bains: all above citations; Ginter: Fig 86, associated text; C339-342: "Example--Distribution of Content Control Information Within an Organization"), intended to be used by licensed users, and gathers data on the usage of the licensed property including by reference to a plurality of licensors of the license property; and monitoring software that interfaces with the license manager and extracts from it licensor-specific data and authenticates (Ginter: C21, L41 – C22, L25) the retrieved data such that licensors are assured, based on a set of license-specific rules, that data gathered by the license manager has not been altered or improperly deleted prior to its being provided to licensors.*

As per **claims 2 and 18.**

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Both Bains and Ginter further disclose:

*... the licensed property comprises computer software (Bains: Abstract; Ginter: C4, L14-27).*

As per **claims 3 and 19.**

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Bains further discloses that an encrypted log file of license usage will be maintained (Bains: Fig 2, associated text). Neither Bains nor Ginter specifically discloses that the users will be able to review log data. However it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have made the data viewable by users, so that they can themselves review how much usage

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they've incurred, while providing for tamper-proof recording of the same data, so that licensors will trust that the license monitor is providing accurate logs. Such a system would meet all the limitations recited in claims 3 and 19:

*... the monitoring software includes a facility that enables users to review data before it is sent to licensors and prevents users from modifying such data.*

As per claims 4 and 20.

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Both Bains and Ginter further describe using passwords and certificates for authorizing licenses (Bains: C1, "Background Art", L39-40; Ginter: C8, L1-7; C210, L49-58]. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have incorporated the use of passwords and certificates to authorize usage of licensed property, to provide trusted communications:

*... the license manager includes a facility that accepts passwords and license certificates for authorizing usage of respective ones of the licensed property.*

As per claims 5 and 21.

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Neither reference specifically discloses gathering out-of-compliance data. However Bains does disclose that his license monitoring system would log all instances of license requests (Bains, Figs 1-2, associated text). Therefore a system set up according to the teachings of Bains and Ginter combined would inherently save all instances of out-of-compliance license requests as well. This would be a useful feature to allow licensors/administrators to analyze usage trends and adjust license policies accordingly:

*... the gathered data comprises out-of-compliance data.*

As per claims 6 and 22.

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

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Ginter further discloses that certificates that have been decommissioned should be recognized and used to prevent licensing of users/sites with such expired certificates (Ginter: C210, L59 – C211, L17).

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have incorporated the maintenance of a certification modification database, to ensure that only authorized current certificate holders would have access to the data.; a record of such modification data would also allow better management of content delivery and planning:

*... the gathered data comprises license certificate modification data.*

As per claims 7 and 23.

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Ginter further discloses that creators/licensors may directly provide or modify instructions to the monitoring software (Ginter: C339-342: "Example--Distribution of Content Control Information Within an Organization"). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to add this feature in order to immediately implement changes to the license monitoring process, rather than wait for a regular timed update of the licensing monitor:

*... the monitoring software includes a facility that enables licensors to directly and remotely provides instructions to the monitoring software.*

As per claims 8 and 24.

Bains in view of Ginter disclose all the limitations of claims 1 and 23, respectively.

Both Bains and Ginter disclose that monitoring agents may be run on a user's computer (Bains: Fig 1, associated text; Ginter: C6. L14-28).

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have incorporated this feature as taught by both references, in order to provide automated monitoring, thus negating the need for licensors to manually intervene in the process:

*... direct access to the monitoring software is granted to an agent operating on behalf of a licensor but which is active on a user's computer.*

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As per claims 9 and 25.

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Both references disclose that multiple products may be licensed and monitored accordingly (Bains: Fig 1, associated text; Ginter: Fig 86, associated text). Therefore it would have been obvious for one ordinarily skilled in the art at the time the invention was made to have usage data gathered based on the ID of each product and/or licensor monitored, in order to provide a clear view of which product was being used, how, and when:

*...further including an operator control facility that enables controlling the monitoring software to carry out a data gathering task based on selection criteria and the selection criteria includes at least identification of products or licensors.*

As per claims 10 and 26.

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Bains further discloses the capability of his system to periodically communicate with a license server (Bains: C7, L42-50). Bains teaches that an automated reporting system may be set up, wherein data can be forwarded to a license server or licensor, based on a periodic timer. It would have been obvious for one ordinarily skilled in the art at the time the invention was made to include this monitoring operation, in order to automatically provide current, up-to-date license usage, so as to allow for rapid changes/additions to the licensing rules:

*... the monitoring software is operable on a time scheduling basis.*

As per claims 11 and 27.

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Ginter further discloses that his system may use symmetric key encryption (Ginter: C66-67: "SPU Encrypt/Decrypt Engine"). Therefore it would have been obvious for one ordinarily skilled in the art at the time the invention was made to include this common and inexpensive encryption technique for securing the communications from the monitor to the licensor:



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*... including a facility for creating a new symmetric encryption key for encrypting the data to be transferred to licensors.*

As per **claims 12 and 28.**

Bains in view of Ginter disclose all the limitations of claims 11 and 27, respectively.

Ginter further discloses that a preferred embodiment of his system will use an additional asymmetric encryption method, using public/private encryption keys for stronger protection of data and transmissions (Ginter: same citation as above). It would have been obvious for one ordinarily skilled in the art at the time the invention was made to make this further encryption available, where the need for securing transmissions from the monitor to the licensor is more significant:

*... a facility that encrypts the symmetric encryption key using a public key of a licensor.*

As per **claims 13 and 29.**

Bains in view of Ginter disclose all the limitations of claims 11 and 27, respectively.

As cited and analyzed above, Ginter further teaches that transmissions from each participant may benefit from an asymmetric encryption protocol on top of a symmetric one. It would have been obvious for one ordinarily skilled in the art at the time the invention was made to make this further encryption available, this time using the user's public key, so that transmissions from the user can be securely and uniquely authenticated:

*...including a facility that encrypts the symmetric encryption key using a public key of a user.*

As per **claims 14 and 30.**

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Both Bains and Ginter further disclose using encryption to secure data, including license data (see all above citations; Bains: Fig 1-2, associated text). It would have been obvious for one ordinarily skilled in the art at the time the invention was made to make this feature available, in order to ensure the security of the data file to be transmitted to the licensor:

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*... further including an authenticating facility which is operable as a part of the monitoring software and which authenticates data that is gathered for a licensor, to prevent tampering with such data.*

As per **claims 15 and 31**.

Bains in view of Ginter disclose all the limitations of claims 14 and 30, respectively.

Ginter further discloses using a hash method for further encrypting data transmissions (Ginter: Col 131: "SPE secure database manager"). It would have been obvious for one ordinarily skilled in the art at the time the invention was made to further implement this teaching from Ginter, in order to provide even stronger encryption of the licensing data. An embodiment of such a system would meet all the further limitations of claims 15 and 31:

*... the authentication comprises a message digest and the message digest is a data digest selected from the group consisting of a hash value or an arithmetic total computed from encrypted data which is then encrypted using a private key specific to the monitoring software.*

As per **claims 16 and 32**.

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Ginter further discloses that many different types of digital properties may benefit from his system (see Ginter citations above): It would have been obvious for one ordinarily skilled in the art at the time the invention was made to apply this licensing monitoring to all types of digital properties that may be used or accessed by multiple users, so that accurate accounting of their use may be monitored:

*... the licensed property is selected from a property group consisting of: licensed software, trade secrets, copyrighted music, copyrighted books, copyrighted photos, copyrighted movies, and copyrighted videos.*

As per **claims 33 and 34**.

Bains in view of Ginter disclose all the limitations of claims 28 and 12, respectively

As cited and analyzed above, Ginter further teaches that transmissions from each participant may further benefit from multiple encryption protocols using asymmetric and symmetric algorithms performed on various unique items including a user's cryptographic public key. It would have been obvious for one

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ordinarily skilled in the art at the time the invention was made to apply these stronger encryption methods when a very high degree of security is desired:

*...further including encrypting the symmetric encryption key which has been encrypted using the public key of the licensor, with a user's public key and subsequently providing such twice encrypted information to a respective user.*

As per **claims 35 and 38.**

Bains in view of Ginter disclose all the limitations of claims 1 and 17, respectively.

Ginter further discloses the use of clearinghouses in his system (Ginter: Col 3, L25-30; Fig 77, associated text). Therefore it would have been obvious for one ordinarily skilled in the art at the time the invention was made to further implement this teaching from Ginter, in order to provide an independent, central service for billing and accounting based on license usage for many different products:

*...further including a central clearinghouse facility, the monitoring software accumulating licensor-specific data pertaining to a plurality of licensors and transmitting the same to the central clearinghouse facility, the clearinghouse facility consolidating, sorting and providing the licensor-specific data according to licensors.*

As per **claims 36 and 39.**

Bains in view of Ginter disclose all the limitations of claims 35 and 38, respectively.

Using the same motivation analysis cited for claims 8, 24 and 10, 26 above, further setting up an automated process for providing licensing data from monitor software to clearinghouse would be obvious to one ordinarily skilled in the art at the time the invention was made:

*... the monitoring software and the central clearinghouse facility interact with each other automatically.*

As per **claims 37 and 40.**

Bains in view of Ginter disclose all the limitations of claims 35 and 38, respectively.

Using the same motivation analysis cited for claims 7 and 23 above, further setting up a process for directly accessing the licensing monitoring and prompting it to provide data or to modify license policies would be obvious to one ordinarily skilled in the art at the time the invention was made:

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*... the monitoring software and the central clearinghouse facility interact with each other in response to prompting by specific licensors.*

**Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

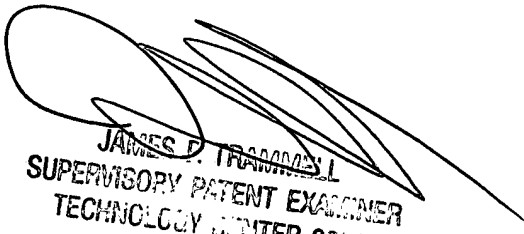
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL

  
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